

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application

Inventors: Naoyasu MIYAGAWA, et al.

Appln. No.: 09/460,222

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For: OPTICAL RECORDING/REPRODUCING APPARATUS FOR OPTICAL
DISKS WITH VARIOUS DISK SUBSTRATE THICKNESS

REPLY BRIEF

This Reply Brief addresses various points raised in the Examiner's Answer. It is submitted that the per se approach to recapture estoppel set forth in the Examiner's Answer is improper in view of the Board's rejection of such an approach in the precedential Board decision in *Ex parte Eggert et al.*¹ decided May 29, 2003.

I. THERE IS NO SURRENDERED SUBJECT MATTER BASED ON THE
PRECEDENTIAL CCPA DECISION IN IN RE WESSELER

In reissue recapture, surrender requires cancellation, amendment or argument for the purpose of overcoming a prior art rejection. See, *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed.

¹Appeal No. 2001-0790, May 29, 2003. Hereinafter, "*Ex parte Eggert et al.*" or "*Eggert et al.*" refers to this decision and not the earlier board decisions also involving *Eggert et al.*

Cir. 1997). *In re Wesseler*² held that there is no surrender based on a prior art rejection, where the canceled claims were subject to both an indefiniteness rejection and a prior art rejection and the record contains nothing to indicate cancellation, amendment or argument to overcome the prior art rejection.

Under *In re Wesseler*,³ if there is both a Section 112 rejection and a prior art rejection and the record contains nothing to indicate cancellation, amendment or argument to overcome the prior art rejection, there is no surrender based on a prior art rejection.

The facts underlying the Appellants' present application are virtually identical in pertinent point to those described by the court in *Wesseler*. Prior to the cancellation of claims in the original patent application for both *Wesseler* and Appellants, all claims stood rejected as being vague and indefinite. Also, in *Wesseler*, claims 11, 12, 20, and 21 of the patent application were also rejected as unpatentable over a patent to Simmonds, and in Appellants' case, claims 1 and 6 were rejected over prior art. In *Wesseler* and in the present case, the PTO alleged improper

²367 F.2d 838, 151 USPQ 339 (CCPA 1966). The CCPA's decision in *Wesseler* is binding legal precedent.

³*In re Wesseler* is discussed in detail in Appellants' Main Brief. It is binding precedent and has never been overruled or modified by the Federal Circuit.

recapture. Also, in both *Wesseler* and in the present case, the PTO alleged, either expressly or impliedly, that the Appellants had acquiesced to the rejection made by the examiner and thus surrendered the subject matter of the cancelled claims.

Applying *In re Wesseler* to the present case, there was no surrender invoking the recapture rule because the prosecution history and claim amendments and cancellations fail to support any inference that original claims 1 and 6 were canceled to overcome a prior art rejection.

The CCPA stated in *Wesseler* that:

[i]nsofar as the act of cancelling claims is concerned the record does not show whether this was an admission that those claims were unpatentable over the prior art or whether they were cancelled and the amended claims were submitted to cure the 'vague and indefinite' rejection. *Id.*, at 345, 346.

Similarly, the record of the present application is silent as to whether the cancellation of claims 1 and 6 was an admission that those claims were unpatentable over the prior art or whether they were cancelled in view of the "vague and indefinite" rejection. The CCPA's decision in *Wesseler* is binding legal precedent for the present situation. Therefore, the law applied to the *Wesseler* situation should be similarly applied to the present situation.

Similarly to the principles of *Wesseler*, *In re Petrow*⁴ stated that where the deliberate cancellation of a claim does not amount to an admission that the reissue claims were not patentable at the time the original claims were canceled, there is no surrender and no recapture estoppel. The court stated:

There are not sufficient facts in the record to base a holding that the cancellation of claim 4 was in any sense an admission, the applicant amended the claims to put claims in proper form under a 112 product by process claim. *Petrow* at 450-451.

Thus, *Wesseler* and *Petrow* stand for the proposition that the recapture rule does not apply absent evidence that applicant's amendment was an admission that the scope of that claim was not in fact patentable over the prior art.

Here, the Examiner's Answer does not even assert that the cancellation of claims 1 and 6 was to overcome the prior art.

Here, similarly to *Wesseler*, the cancellation of claims 1 and 6 and the amendments to the allowable claims were done in order to present the claims in a form to allow the invention to be understood.

Thus, under the principles of *In re Wesseler* and *In re Petrow*, there was no surrender invoking the recapture rule in the present

⁴159 USPQ 485 (CCPA 1968).

case, because the prosecution history and claim amendments and cancellations fail to support any inference that original claims 1 and 6 were canceled to overcome a prior art rejection.

II. EVEN IF SURRENDER OCCURRED, THERE IS NO RECAPTURE
OF SURRENDERED SUBJECT MATTER

The central argument in the Examiner's Answer is that, if there is a broadening aspect that relates to surrendered subject matter, then *per se* the reissue claim is barred by the recapture rule.

Contrary to the position taken in the Examiner's Answer, the Federal Circuit has not held that germane broadening is a *per se* violation of the recapture doctrine. This *per se* approach has been expressly condemned in *Ex Parte Eggert et al.* As noted by the Board, this *per se* rule is contrary to express statements in *Clement* and *Pannu*. Such a rule would negate broadening reissue under 35 USC 251 with respect to claims amended or argued to gain patentability over the prior art, as well as possibly claims allowed on first action but subject to an examiner's reasons for allowance in the notice of allowability. In other words, virtually all broadening reissues would be precluded. If this *per se* rule were to prevail, the reissue statute would be of very little practical value, given that virtually all cases undergo claim amendments, arguments for allowance or examiner's reasons for

allowance during prosecution.

Ex parte Eggert et al. clarified what constitutes surrendered subject matter and what is to be the focus in determining germane broadening and narrowing.⁵ The Board stated that the canceled claim constitutes surrendered subject matter, but the subject matter intermediate of the canceled and the issued claim does not. *Ex parte Eggert et al.*, page 5. The Board stated that the focus should be the claim from which the issued claim directly evolved, not the issued claim itself. *Infra*, page 6. The Board stated that a rigid *per se* rule is not consistent with the remedial nature of the reissue statute and is not supported by the legal precedent of the Federal circuit. *Infra*, page 14.

The Board cited the following portion of *Clement*:

Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, we then determine whether the surrendered subject matter has crept into the reissue claim. Comparing the reissue claim with the canceled claim is one way to do this. If the scope of the reissue claim is the same as or broader than that of the canceled claim, then the patentee is clearly

⁵To the extent that Appellants' Main Brief may have advanced legal analysis of germane broadening different from that of *Ex Parte Eggert et al.*, the Appellants' prior statements are withdrawn. Specifically, the Appellants' prior statements concerning possible broadening aspects of the present reissue claims focus on broadening relative to the features added to the patent claims that were not in original claim 1, rather than broadening of the features of original canceled claim 1; these prior statements are withdrawn.

attempting to recapture surrendered subject matter and the reissue claim is, therefore, unallowable. In contrast, a reissue claim narrower in scope escapes the recapture rule entirely. *In re Clement* at 1469, 45 USPQ2d at 1164.

The Board noted that *Clement* and *Pannu*⁶ clearly leave open the possibility that reissue claims which have been broadened in an aspect related to surrendered subject matter may avoid the recapture rule if they are materially narrowed in other respects. *Infra*, page 30. The Board stated that the proper inquiry requires a fact-specific analysis in each case to determine whether the patentee is attempting to recapture surrendered subject matter, in accordance with the basic test of *Clement*. *Infra*, page 31. The Board noted that the narrowing features in *Pannu* were contained in original claim 1 and a dependent claim throughout prosecution and thus were not overlooked aspects of the original patent. *Infra*, page 34, footnote 14.

The Board stated:

For example, if an outer circle claim contains elements ABC and the inner circle claim contains elements ABCDEF, a reissue applicant cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside the outer circle (e.g., AB, BC, ABC_{BR2}, etc.). However, it is our view that the reissue recapture rule is not invoked for claims directed to elements ABCX,

⁶*Pannu v. Storz Instrument, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001).

ABCD_{BR}, ABCEF, A_{BR}BCDEF. In other words, the focus for determining the reach of the reissue recapture rule should be the claim from which the issued claimed directly evolved, not the issued claim itself. We believe that this is where we and the members of the dissent disagree. *Infra*, page 6.

The Board recognized that recapture is avoided in some circumstances where the reissue claims are materially narrowed in respects other than those in which the reissue claims are broadened. Further, the Board recognized that recapture does not exist when the reissue claims are materially narrower in overlooked aspects of the invention and that the patentee may obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects. *Infra*, page 29.

Following the *Clement* test, the Board in *Eggert et al.* applied a three step analysis as follows. First, the Board compared the reissue claims with the patent claims to determine whether and in what "aspect" the reissue claims are broader than the patent claims. Secondly, having determined that the reissue claims have been broadened relative to the patent claims, the Board next determined whether those broadenings relate to surrendered subject matter. Thirdly, the Board compared the rejected reissue claims to the surrendered subject matter to determine in what aspects the reissue claims are broader than the surrendered subject matter and in what aspects the reissue claims are narrower than the

surrendered subject matter, with the surrendered subject matter being the claim prior to the amendments resulting in its allowance.

In the present case, the material narrowings are directed to overlooked aspects of the invention that were never claimed in the original application. On this point, both *Clement* and *Pannu* involved facts significantly different from the present case. *Clement's* narrowing aspect related to a feature in the patent claims, while *Pannu's* narrowing aspect related to a feature in the original claim but canceled from the patent claims. Thus, in *Clement*, there was no narrowing relative to the patent claims, and in *Pannu*, the narrowing aspect was not material because it was deemed insufficient during prosecution to impart patentability. Moreover, the *Pannu* narrowing aspect was *not an overlooked aspect of the invention*. In contrast, the numerous narrowing aspects of the present reissue claims were not recited in any of the original claims and thus are overlooked aspects.

In the present case, as pointed out in Appellants' Main Brief, there are numerous aspects of material narrowing of the converging means with the aberration correction feature of this invention.⁷ Each of these narrowing features was never recited in any claim during prosecution of the original patent and thus constitutes

⁷Reiteration of these narrowing aspects is omitted herein for brevity.

overlooked subject matter. Further, Appellants' claims depart further from recapture of surrendered subject matter in that the present claims are directed to overlooked embodiments. For example, here, the reissue claims are directed to the fourth embodiment illustrated in Figs. 9A and 9B. There were no original claims directed to this embodiment.

Thus, the Appellants are entitled to obtain the present reissue claims which are directed to overlooked embodiments in the original application.

The above-noted numerous aspects of material narrowing are more than sufficient to avoid recapture estoppel.

For the above reasons, it is submitted that the present reissue claims are not barred by recapture estoppel.

III. Rebuttal of Specific Points Asserted in the Examiner's Answer

The Examiner's Answer raises issues concerning alleged narrowing amendments to the allowable dependent claims. However, since these dependent claims were not subject to a prior art rejection, the reasons for their amendment could not have been to overcome a prior art rejection, and there is nothing in the record to indicate otherwise.

In fact, as noted above, the Appellants' sole statements during prosecution explained how the amendments overcame the

Section 112 rejection, stating that these claims were "rewritten in independent form and also amended to overcome the 112, second paragraph, rejections."

The Examiner's Answer particularly asserts that allowable claims 2, 4, 5 and 7-9 were not placed in independent form to include each and every limitation of independent claim 1. Differences specifically noted in the Examiner's Answer relate to claims 4, 5 and 7.

In regard to claim 4, the Examiner's Answer states:

In addition, applicant argued what appears to be the patentable subject matter that defines over the prior art in claim 4; stating "control means selects one of the plurality of the light emitting means which are associated with the converging optical systems. By selecting one of the light emitting means, an aberration caused by the difference of the disc substrate thickness is minimized." (See Examiner's Answer, page 5, lines 11-14.)

It should be noted that applicant's arguments concerning claim 4 are inconsistent with the amendment in that the arguments are drawn to "selecting"; whereas the amendment to claim 4 deleted the word selecting and replaced it with the word--allowing--." (See Examiner's Answer, page 5, lines 18-20.)

But Appellants' note that original claim 4 used both the term "allowing" and the term "selecting." As explained in Appellants' Remarks accompanying the Amendment, the claim amendments were merely for clarity to overcome the indefiniteness rejection. If

anything, the amendment from "selecting...and allowing" to "allowing" is broadening rather than narrowing.

In regard to claims 5 and 7, the Examiner's Answer states:

[a]pplicant raised the issue that "control means is defined as generating a control signal which is provided to the selecting means in accordance with the discrimination signal."

Again, as explained in the Remarks accompanying the Amendment, this statement was intended merely to explain why the claim was definite and satisfied Section 112, second paragraph. This statement merely paraphrased the claim language and was not narrower than the description of the control means of claims 5 and 7. The assertions in the Examiner's Answer are unwarranted.

The Examiners' Answer further states:

It should also be noted that amendments to claims 2, 4, 5, 7, 8, and 9 were more substantive in nature than specifically argued in attorney remarks. (See Examiner's Answer, page 5, lines 20 - page 6, line 2.)

The Examiner's Answer asserts that claims 2, 4, 5 and 7-9 were amended both to overcome the indefiniteness rejection and the prior art rejection.

Appellants submit that the characterization of the amendments to claims 2, 4, 5 and 7-9 is unfounded. As noted above, the Remarks explained that the amendments were made to place the claims

in independent form and to overcome indefiniteness. As noted above, these claims were never subject to a prior art rejection. Thus, any amendment thereof was not for the purpose of overcoming a prior art rejection but rather to correct indefiniteness. The only statements in the record regarding these amendments are those explaining how the claim amendments place the claims in independent form and overcome the 112, second paragraph, rejection. Thus, the assertions in the Examiner's Answer regarding narrowing amendments to claims 2, 4, 5 and 7-9 beyond merely placing them in independent form are irrelevant under recapture as defined by decisions of the Federal Circuit and under *Ex parte Eggert et al.*

Finally, the Examiner's Answer stated that Appellants made up a category (c) under *Clement*, i.e., where the reissue claim is as broad as or broader than the canceled or amended claim in an aspect germane to a prior art rejection and narrower in another aspect germane to the prior art rejection; in such case, the recapture rule may not bar the claim. However, this category was in fact recognized in *Ex parte Baudin*⁸ and *Ex parte Eggert et al.* Regarding category (c) of *Clement*, *Ex parte Baudin* expressly recognized this third category of *Clement*, stating:

The court in *Clement* held that reissue claim 49 was both broader and narrower in areas relevant to the prior art rejection. Comparing reissue claim 49

⁸*Ex parte Gilles Baudin*, Appeal No. 2001-1042, Application No. 09/292,334, BPAI, June 13, 2001

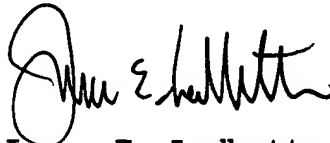
with claim 42 before the May 1988 and June 1987 amendments, the court found that claim 49 was narrower in one area, namely, the brightness is 'at least 59 ISO in the final pulp.' This narrowing related to a prior art rejection because, during the prosecution of the '179 patent, Clement added this brightness limitation in an effort to overcome Burns. *Id.*, at page 25.

Thus, it is submitted that the comments in the Examiner's Answer regarding category (c) of Clement are not well taken.

IV. CONCLUSION

For the reasons set forth above, the Appellants respectfully request this honorable Board to reverse the pending rejection.

Respectfully submitted,



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